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BATES, KEVIN T

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVE MCDYSAN, HOWARD LEE THOMAS, and LEI YAO

Appeal 2009-003742
Application 09/723,480
Technology Center 2400

Decided: March 31, 2010

Before JOSEPH L. DIXON, JAY P. LUCAS, and THU A. DANG,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

I. STATEMENT OF THE CASE

Appellants have filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(1) (hereinafter “Request”) on October 26, 2009, for reconsideration of our Decision mailed September 17, 2009 (hereinafter “Decision”) with respect to claims 1-15, 21, and 26 (Request 2).

The Decision affirmed the Examiner’s rejection of claims 1-4, 7-9, 12, 13, 17, 20-24, 27, 28, 31, 32, 36, 39, and 40 under 35 U.S.C. § 102(e) as being anticipated by Albert; the rejection of claims 5 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Albert in view of Haas; the rejection of claims 16, 18, 35, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Albert in view of Feldman; the rejection of claims 19 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Albert in view of Grant; the rejection of claims 10, 11, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Albert in view of Gai; and the rejection of claims 6, 14, 15, 26, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Albert in view of Gibson (Decision 12-13).

We have reconsidered our Decision of September 17, 2009, in light of Appellants’ comments in the Request, and we find Appellants have not identified any points misapprehended or overlooked by the Board in our Decision therein. We decline to change our Decision for the reasons discussed *infra*.

II. ISSUES

The issues we address on this Decision on the Request are whether Appellants have identified any points misapprehended or overlooked by the Board in our finding that:

- 1) Appellants' repetition of the claim language on pages 7-8 of the Appeal Brief is a "mere general allegation of patentability" (Request 2);
- 2) Such a general allegation of patentability does not meet Appellants' burden of showing error in the Examiner's conclusion (*Id.*); and
- 3) Albert's forwarding agents and servers are in two different networks (Request 3).

III. PRINCIPLES OF LAW

Appellants bear the procedural burden on appeal to the Board to move forward by showing harmful error in the Examiner's rejections. *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (citation and internal quote omitted).

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

If the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)).

IV. ANALYSIS

Issue 1

Appellants contend that “Appellants set forth, in great detail, at pages 10-12 of the principal Brief, and pages 3-4 of the Reply Brief, exactly why these highlighted portions of the claims distinguish over *Albert et al.*,” and thus, we erred in finding Appellants’ repetition of the claim language on pages 7-8 of the Appeal Brief as “mere general allegation of patentability” (Request 2).

We agree with Appellants that pages 10-12 of the principal Brief set forth Appellants’ substantive arguments. However, all of these substantive arguments, set forth on pages 10-12, were addressed in the Decision (Decision 6-11). Accordingly, Appellants have not identified any points misapprehended or overlooked by the Board in our Decision. That is, as admitted by Appellants and as set forth in our Decision, the claim language provided on pages 7-8 is not considered substantive arguments as required by 37 C.F.R. 41.37(c)(vii), and our observation of that finding does not constitute an error of the Board.

Issue 2

Appellants contend that we erred in concluding that Appellants' repetition of the claim language on pages 7-8 of the principal Brief "is wholly ineffective in demonstrating error in the Examiner's *prima facie* case" and thus "does not meet Appellants' burden" of showing error in the Examiner's case (Request 2). In particular, Appellants contend that "[i]t is not Appellants' burden, in the first instance, to proffer evidence of patentability" and that "[i]t is only after the Examiner establishes a *prima facie* case of anticipation that the burden shifts to Appellants to present arguments and/or evidence to rebut such *prima facie* case" (*Id.*).

We agree with Appellants that it is not Appellants' burden to initially proffer evidence of patentability. However, as admitted by Appellants, after the Examiner presents a *prima facie* case of anticipation, the burden shifts to Appellants to present arguments and/or evidence to rebut such *prima facie* case. That is, though Appellants do not initially have the burden of establishing *prima facie* case of patentability, Appellants bear the procedural burden on appeal to the Board to move forward by showing harmful error in the Examiner's rejections. See *In re Kahn*, 441 F.3d at 985-86. As set forth in our Decision, the claim language reiterated on pages 7-8 of the principal Brief does not meet Appellants' burden of showing harmful error in the Examiner's rejection (Decision 6). In fact, as admitted by Appellants, Appellants' substantive arguments are provided on pages 10-12 of the principal Brief (Request 2). Thus, we find no error in our finding that the listing of the claim language on pages 7-8 does not meet Appellants' burden

of showing harmful error. Hence, Appellants have not identified any points misapprehended or overlooked by the Board in our Decision.

Issue 3

Appellants also contend that we erred in finding that Albert's forwarding agents and servers are in two different networks (Request 3). However, as set forth in our Decision, we gave the claims their broadest reasonable interpretation, but would not read limitations into the claims from the specification (Decision 9). *See In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) and *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

As we noted in our Decision, the language of claim 1 simply does not place any limitation on what the term "network" (and thus "network interface") is to be, is to represent, or is to mean, other than that "the second network is different from the first network" (Decision 8). In fact, even Appellants admit that "the servers 220 in *Albert et al.* could, conceivably, be located within a network separate from a network comprising the forwarding agents 231, 232, and service managers 1 and 2" (Reply Br. 3). That is, though Appellants argue that "Appellants never argued the second network is always and exclusively located within a network separate from the first network" (Request 5), Appellants admit that servers 220 could be located in a network separate from the network comprising the forwarding agents 231, 231 (Reply Br. 3). That is, Appellants admit that the servers could be located in separate network from that of the forwarding agents some of the times.

As set forth in our Decision, we agreed with the Examiner's finding that "[t]he servers are not part of the agents, they exist as separate nodes in the networked system" and that since "the connection between the servers and the forwarding agent is different than the network between the client and the forwarding agents ... those connections can be considered separate 'networks'" (Decision 10). Appellants have not identified any error in such finding by the Examiner, and Appellants have not identified any points misapprehended or overlooked by the Board in our Decision.

Accordingly, Appellants' arguments concerning "forwarding agents and servers" not being "in two different networks" do not persuade us to modify our Decision to designate the rejection of claim 1 affirmed therein as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Therefore, we find Appellants' arguments unavailing.

V. CONCLUSION

We have carefully considered the points and arguments raised by Appellants in the Request for Rehearing, but find no points misapprehended or overlooked by the Board in our Decision and none of these arguments are persuasive that our original Decision was in error. We are still of the view that the invention set forth in claims 1-40 is unpatentable over the applied prior art based on the record before us in the original appeal. This Decision on Appellants' Request for Rehearing is deemed to incorporate our earlier Decision (mailed September 17, 2009) by reference. *See* 37 C.F.R. § 41.52(a)(1).

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VI. DECISION

We have granted Appellants' request to the extent that we have reconsidered our Decision of September 17, 2009, but we deny the request with respect to making any changes therein.

REHEARING DENIED

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